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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/353,670	07/15/99	PRELL	31017870165

BAKER & BOTTS LLP  
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NEW YORK NY 10112

HM12/0319

EXAMINER
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WILSON, J

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/19/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in** accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-16 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

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—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to a composition comprised of imidazoleacetic acid-ribonucleotide (IAA-RP), classified in class 514, subclass 43.
- II. Claims 4-6, drawn to a method for regulating the biological activity of an imidazoline receptor, classified in class 530, subclass 388.22. ~~424/85~~ + 514/43
- III. Claim 7, drawn to an antibody, classified in class 530, subclass 388.21.
- IV. Claims 8-11, drawn to a method for diagnosing a disease or a disorder associated with IAA-RP, classified in class 435, subclass 6.
- V. Claims 12-15, drawn to a method for assaying for compounds which modulate IAA-RP activity, classified in class 435, subclass 7.91.
- VI. Claim 16, drawn to a method for identifying compounds which bind to an IAA-RP compounds, classified in class 435, subclass 7.91.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case .

Inventions of Group I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and

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the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a regulator for the biological activity of an imidazoline receptor and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions of Group I and II and Groups III-VI are unrelated, however Groups I and II are related and Groups III, IV, V, and VI are seen to be related. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve two distinct compositions and methods directed to the use of each of the distinct compounds. The mode of action for the compounds in the methods claimed are different and composition dependent. The compositions of matter set forth in Groups I and III respectively also have different modes of action and different effects contingent upon the methodological procedures claimed.

Inventions of Group III and Groups IV, V and VI are related as product and materially different processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the invention of Group III may be used in any one of the materially different processes of Groups IV, V or VI.

Because these inventions are distinct and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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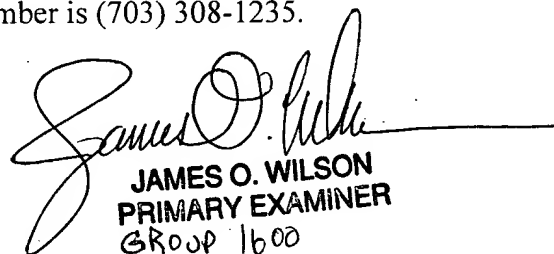
Because these inventions are distinct for the reasons given above and the search required for Group I and II is not required for Group III, IV, V, VI, restriction for examination purposes as indicated is proper and because these inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Wilson. The examiner can normally be reached on Monday-Friday between the hours of 10:00 a.m. and 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, SPE of Art Unit 1623, may be reached at (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



**JAMES O. WILSON**  
**PRIMARY EXAMINER**  
Group 1600